

23. A fashion wear item, comprising:

a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces; and

a peelable material covering said non-skin irritating adhesive to protect the adhesive material until it is ready for use to facilitating decorating a contoured area of a user selected body part.

REMARKS

In response to the Office Action mailed October 29, 2002, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

The claim amendments presented in this response after a final rejection were not presented earlier as it was felt that the claims as pending earlier patentably distinguished over a Band-Aid as more fully argued in applicant's response of May 20, 2002. The amendments to claims 21-23 now presented are made to distinguish more clearly over a Band-Aid, and are fully supported by the specification as originally filed, do not introduce new matter, and thus, do not require a new search on the part of the examiner.

Election/Restriction

In response to the election restriction, applicant affirms the election of Group A, claims 1-5, 7-10, and 12-33 drawn to a novelty fashion wear item and novelty kit. In this regard, applicant has canceled the non-elected species of Group B, and more particularly, applicant has canceled claims 6 and 11, drawn to a protective shell.

### Drawing Corrections

The examiner in the Official Action dated August 1, 2002, had objected to the drawings. Responsive to this objection, attorney for applicant submitted with the Amendment filed September 30, 2002, a new set of formal drawings to be substituted for the informal drawings originally submitted. No acknowledgement was indicated by the examiner in the Official Action dated October 29, 2002, that such drawings were accepted. Attorney for applicant respectfully requests such acknowledgement from the examiner.

### Allowed and Allowable Claims

Attorney for applicant gratefully acknowledges that the examiner has allowed claims 4, 5, 9 and 10.

### Rejections

#### Rejections Under 35 USC §102(b)

Claims 1, 3, 7, 21-24 and 29-33 have been rejected under 35 USC §102(b), as being anticipated by *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)*.

Claim 21 as now pending provides as follows:

"21. A novelty fashion wear item, comprising:  
a flexible pad having an upper surface and a lower surface with a non-slip texture;  
said pad being sufficiently flexible to conform to a contoured surface area of a body part;  
said pad having its entire upper surface coated with an adhesive material for removably securing said pad to said contoured surface area of a body part to facilitate decorating said contoured surface area; and  
said pad having its lower surface provided with indicia to decorate said contoured surface area."

Nowhere is this combination of elements and steps described in, nor suggested by the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference.

"Anticipation is established only when a single prior art reference discloses expressly or under the principles of inherency, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CA FC) 221 U.S.P.Q. 385. The standard for lack of novelty that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and *Cool-Fin Elecs. Corp. v. International Elec. Research Corp.*, 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).

In the present Office Action, the Examiner's rejection is based on the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference, which fails to show all of the essential elements of the instant invention.

The *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference describes, "an adhesive covering with a gauze pad in the center, used for protecting minor abrasions and cuts." See The Random House College Dictionary, Revised Edition ISBN 0-394-43600-8 thumb-indexed edition, 1979, page 105 re: definition for "Band-Aid". More particularly, a "Band-Aid" is a sterile protective surgical dressing in the form of a bandage.

The novel features of the present invention are not disclosed, nor suggested by the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference in that the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* does not disclose, nor suggest a "A novelty fashion wear item, comprising: a flexible pad having ... its entire upper surface coated with an adhesive material for removably securing said pad to said contoured surface area a body part to facilitate decorating said contoured

surface area..." Instead, the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference describes, "An adhesive covering with a gauze pad in the center, used for protecting minor abrasions and cuts." In short then, the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference fails to teach or disclose, "a flexible pad having ... its entire upper surface coated with an adhesive material..."

Thus, while the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference may teach a bandage with a decorated surface, the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference does not disclose, nor suggest, the novel features and steps of the present invention as claimed. Therefore, claim 21 as amended, and dependent claim 1 and 3, patentably distinguish over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference.

Independent claim 22 has been amended in a similar manner to claim 21. Therefore claim 22 as amended and dependent claims 2, 7 and 8 patentably distinguish over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference under the same rationale as set forth above for claim 21.

Independent claim 23 has been amended in a similar manner to claim 21. Therefore claim 23 as amended and dependent claim 24-32 patentably distinguish over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference under the same rationale as set forth above for claim 21.

#### Rejections Under 35 USC §103

Claims 2, 8, 12-20 and 25-28 have been rejected under 35 USC §103 as being unpatentable over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc.*

2001-2002) reference

Claims 2, 8, 12, 14, 16, 18 and 20 are dependent claims depending from claim 22 as amended. In this regard, claim 22 patentably distinguishes over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference under the same rationale as set forth above for claim 22. Accordingly, claims 2, 8, 12, 14, 16, 18 and 20 also patentably distinguish over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference since it would not have been obvious to cover the entire skin engaging surface of a pad with an adhesive material, as such an adhesive material would tend to remove parts of the upper skin layer when the Band-Aid was removed from the wound area, and thus, causing pain and discomfort to the user of the Band-Aid. Moreover, it would not have been obvious to provide a large Band-Aid that would conform to the contour of user selected body parts consisting of hands, fingers, feet, toes, knees and elbows. In this regard, a Band-Aid by its very definition is a preformed to cover small-localized areas to protect a skin abrasion or wound for healing purposes.

Claims 13, 15, 17 and 19 are dependent claims depending from base claim 21 as amended. In this regard, claim 21 patentably distinguishes over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference under the same rationale as set forth above for claim 21. Accordingly, claims 13, 15, 17 and 19 also patentably distinguish over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference. Moreover, it would not have been obvious to provide a large Band-Aid that would conform to the contour of user selected body parts consisting of hands, fingers, feet, toes, knees and elbows. In this regard, a Band-Aid by its very definition is a preformed bandage (a one-size covering) to cover a skin abrasion or wound. Accordingly, it would not be practical to use a Band-Aid as shoe or a glove, or an elbow pad, or a knee pad as suggested by the examiner. Moreover, there is no such teaching in the cited reference or any reference cited by the examiner that would suggest using a Band-Aid for

such a purpose. Neither would it have been obvious to cover the entire skin engaging surface of a pad with an adhesive material, as such an adhesive material would tend to remove parts of the upper skin layer when the Band-Aid was removed from the wound area, and thus, causing pain and discomfort to the user of the Band-Aid.

In short then, as fully discussed in applicant's response of May 20, 2002, which response is incorporated herein by reference as though fully set forth again, a Band-Aid is not a novelty item utilized to protect healthy tissue, so it would not be obvious to adapt a Band-Aid to cover any part of the body before it is injured or diseased or to provide it as an alternative to a glove, a shoe, an elbow pad, a knee pad, and the like. Accordingly, claims 2, 8, and 12-20 patentably distinguish over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference.

Claims 25-28 are dependent claims depending from base claim 23 as amended. In this regard, claim 23 patentably distinguishes over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference under the same rationale as set forth above for claim 21. Accordingly, claims 25-28 also patentably distinguish over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference.

In summary then, while the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference may teach a sterile protective covering with a decorative surface, the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference does not disclose, nor suggest, the novel features and steps of the present invention as claimed. Therefore, claims 2, 8, 12-20 and 25-28 patentably distinguish over the *Decorative Band-Aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002)* reference.

Conclusion

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

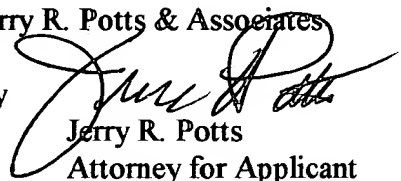
Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: November 21, 2002

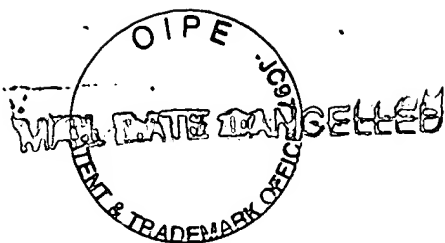
Respectfully submitted,

Jerry R. Potts & Associates

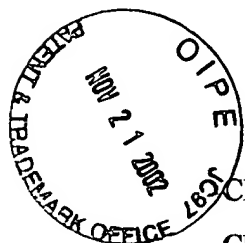
By

  
Jerry R. Potts  
Attorney for Applicant  
Registration No. 27,091  
(760) 822-6201

Jerry R. Potts & Associates  
3248 Via Ribera  
Escondido, CA. 92029  
760-822-6201  
jrpotts@cox.net



## VERSION WITH MARKING TO SHOW CHANGES MADE



Claims 6, 11, and 33 have been canceled without prejudice.

Claims 21-23 have been amended as follows:

RECEIVED

NOV 29 2002

TECHNOLOGY CENTER R3700

21. (Amended) A novelty fashion wear item, comprising:

a flexible pad having an upper surface and a lower surface with a non-slip texture;

said pad being sufficiently flexible to conform to a contoured surface area of a body part;

said pad having its entire upper surface coated with an adhesive material for removably securing said pad to said contoured surface area a body part to facilitate decorating said contoured surface area; and

said pad having its lower surface provided with indicia to decorate said contoured surface area.

22. (Amended) A method of decorating a body part, comprising the steps of:

providing decorative fashion wear;

said fashion wear including:

a flexible pad with a non-slip texture, said pad having an upper surface and a lower surface and being sufficiently flexible to conform to a contoured surface area of the body part;

providing the entire upper surface with an adhesive material for removably securing said pad to the contoured surface area of the body part;

providing the lower surface with indicia to decorate the contoured surface area of the body part; and

applying said decorative fashion wear to the contoured surface area of the body part



for decorating purposes.

23. (Amended) A fashion wear item, comprising:

a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces; and

a peelable material covering said non-skin irritating adhesive to protect the adhesive material until it is ready for use to facilitating decorating a contoured area of a user selected body part.